

REMARKS

Claims 1 through 15 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 12, 14 and 15. Applicants also acknowledge, with appreciation, the Examiner's indication that claims 5 and 6 would be allowed if presented in independent form, as well as claims 7, 8 and 9 insofar as they depend from claim 12.

Claims 1 through 3, 11 and 13 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, various amendments were implemented at the suggestion of the Examiner and address formalistic issues. Adequate support for the present Amendment should be apparent throughout the originally filed disclosure, noting Fig. 1, and the related discussion thereof in the written description of the specification, and Table 1 and the related discussion thereof in the written description. Applicants submit that the present Amendment does not generate any new matter issue.

Claim objections

The Examiner objected to claims 2, 3, 11 and 13, identifying perceived informalities and courteously suggested remedial language. In response, claims 2, 3, 11 and 13 have been amended addressing the issues raised by the Examiner and adopting various suggestions of the Examiner. Applicants submit that the recited bases for the imposed objections have been overcome and, hence, solicit withdrawal of the claim objections.

Claims 1, 7/1, 8/7/1 and 9/7/1 were rejected under 35 U.S.C. § 102 for lack of novelty as evidence by Bhagavatula.

In the statement of the rejection, the Examiner asserted that Bhagavatula discloses an optical fiber corresponding to that claimed referring to, *inter alia*, Fig. 5, curve 56, and to column 6, lines 4 through 8. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003), *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a fundamental difference between the optical fiber defined in independent claim 1 and Bhagavatula's optical fiber that scotches the factual determination that Bhagavatula discloses an optical fiber identically corresponding to that claimed.

Specifically, the optical fiber defined in independent claim 1 has a dispersion slope which is positive at, at least, one wavelength in the range of 1300 nm to 1600 nm. No such fiber is disclosed or suggested by Bhagavatula.

The above argued difference between the claimed optical fiber and Bhavagatula's optical fiber undermines the factual determination that Bhagavatula discloses an optical fiber identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 7/1, 8/7/1 and 9/7/1 under 35 U.S.C. § 102 for lack of novelties evidenced by Bhagavatula is not factually viable and, hence, solicit withdrawal thereof.

Claims 2,3,4, 13, 7/13, 8/7/13 and 9/7/13 were rejected under 35 U.S.C. § 103 for obvious predicated upon Bhagavatula.

This rejection is traversed.

Claims 2, 3 and 4 depend from independent claim 1. Independent claims 1 and 13 are each directed to an optical fiber having a dispersion slope which is positive at, at least, one wavelength in the range of 1300 nm to 1600 nm. No such fiber is disclosed or suggested by Bhagavatula. Accordingly, even if Bhagavatula's optical fiber is modified as suggested by the Examiner in the statement of the rejection, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 2, 3, 4, 13, 7/13, 8/7/13 and 9/7/13 under 35 U.S.C. § 103 for obviousness predicated upon Bhagavatula is not factually or legally viable, and, hence, solicit withdrawal thereof.

Claims 10 and 11 were rejected in the 35 U.S.C. § 103 for obviousness predicated upon Bhagavatula in view of Chang et al.

This rejection is traversed.

Claims 10 and 11 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Bhagavatula. Specifically, Bhagavatula neither discloses nor suggests an optical fiber whose dispersion slope is positive at, at least, one wavelength in the range of 1300 nm to 1600 nm. The additional reference to Chang et al. does

not cure the argued deficiencies of Bhagavatula. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp, supra*.

Applicants, therefore, submit that the imposed rejection of claims 10 and 11 under 35 U.S.C. § 103 for obviousness predicated upon Bhagavatula in view of Change et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Applicants again acknowledge, with appreciation, the Examiner's allowance of the claims 12, 14 and 15, and indication that claims 5 and 6, as well as claims 7, 8 and 9 insofar as they depend from independent claim 12, contain allowable subject matter. Based upon the arguments submitted *supra*, it should be apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

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Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'A. J. Steiner', written over the printed name.

Arthur J. Steiner

Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AJS:ts
Facsimile: (202) 756-8087
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